

### **REMARKS**

The Examiner is thanked for the thorough examination of the application. It is believed that no new matter is added to the application by this Amendment.

### **Status Of The Claims**

Claims 1-4 are pending in the application. The instantly presented amendments to claim 1 better set forth the invention being claimed, and the amendments to claim 1 are fully supported by the scope of original claim 1 (*see* discussion below about 35 U.S.C. §112, first paragraph).

### **Rejection Under 35 U.S.C. §112, First Paragraph**

Claims 1-4 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Applicants traverse.

At page 2 of the Office Action, the Examiner asserts that there is no literal support in the specification for the claimed range (as amended in the Amendment filed February 7, 2006) of 5-35% Al to 25-35% Al in claim 1. However, the 25-35% Al range is encompassed by the 5-35% Al of original claim 1, and applicants have the right to set forth the metes and bounds of the patentable invention even if a specific claim limit is not explicitly set forth in the specification.

United States case law points out that the specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Also, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the applicants specification disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

In this case, the claimed 25-35% Al range is encompassed by the 5-35% Al of original claim 1. The Applicants thus clearly had possession of the claimed invention at the time the application was filed. As a result, claim 1 falls within the aegis of the written description requirement set forth in 35 U.S.C. §112, first paragraph. This rejection is overcome and withdrawal thereof is respectfully requested.

**Rejection under 35 USC §103(a)**

Claims 1-7 stand rejected under 35 USC 103 as being unpatentable over Japanese Patent 411071658 (JP '658) or Japanese Patent 358153752 (JP '752). These rejections are respectfully traversed.

The present invention, as instantly amended, pertains to a novel alloy that contains 10-35% Cr and 10-35% Cu. The patentability of the present invention over JP '658 or JP '752 can be instantly understood from the comparison set forth in the Table below.

%	Previously Amended Claim 1		JP '658	JP '752	Instant Claim 1
	Atom	Weight	Atom	Atom	Atom
Fe	5-35	5-35	<35	16-40	5-35
Co	5-35	5-35	<35	3-40	5-35
Ni	5-35	5-35	<35	Balance	5-35
Cr	5-35	5-35	<10	10-50	<b>10-35</b>
Cu	5-35	5-35	<10	<40	<b>10-35</b>
Al	25-35	12.5-17.4	10-35	5-25	25-35

As is clearly evident, JP '658 contains less than 10% Cr, which has no overlap with the 10-35% Cr of claim 1 of the present invention. Also, JP '752 contains less than 10% Cu, which has no overlap with the 10-35% Cu of the present invention. As a result, there is no overlap of ranges sufficient to evoke a *prima facie* case of obviousness as described in MPEP 2144.05(I).

Therefore, claim 1 is patentable over JP '658 or JP '752. Claims depending upon claim 1 are patentable for at least the above reasons. This rejection is overcome and withdrawal thereof is respectfully requested.

#### **Conclusion**

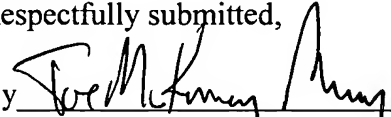
The Examiner's rejections have been overcome, obviated or rendered moot. No issues remain. It is believed that a full and complete response has been made to the outstanding Office Action. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Reg. No. 42,593 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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